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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,893	06/09/1999	JORG SCHABERNACK	Q54532	7430

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[REDACTED] EXAMINER

DUONG, OANH L

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2155

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/328,893	SCHABERNACK ET AL.	
	Examiner Oanh L. Duong	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 March 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ..	6) <input type="checkbox"/> Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al (Bennett) (USPN 5,189,733).

Regarding claim 1, Bennett discloses a method (100) of managing a network element using managed objects (M01, M02, MO*) wherein the network element is managed in response to requests (RQ) by accessing a memory (MEM) and using the objects (M01, M02, MO*) stored therein (see fig. 9), said method (100) comprising the steps of checking in response to a request (RQ = RQ*) for access to one (MO*) of the managed objects (M01, M02, MO*) whether this requested object (MO*) is stored in the memory (MEM) (step 110) (see col. 7 lines 6-9); if this requested object (MO*) is not stored in the memory (MEM), checking whether there is sufficient memory space to write this object (MO*) into the memory (MEM) (step 120) (see col. 7 lines 9-13); if there is no sufficient memory space, swapping at least one (M01) of the stored objects (M01, M02) out of the memory (MEM) to a database (DB) according to at least one predetermined criterion (step 130) (see col. 7 lines 13-18); and reading the requested object (MO*) from the database(DB) and writing it into the memory (MEM) (step 140) (see col. 7 lines 18-24).

Regarding claim 2, Bennett discloses the objects (M02) which are accessed most frequently remain in the memory (MEM) (see col. 7 lines 16-18).

Regarding claim 3, Bennett discloses a predetermined number of recently accessed objects remain in the memory (see abstract).

Regarding claim 5, Bennett discloses the predetermined criterion is a length of time which indicates how long each of the objects may remain stored in the memory (see col. 2 lines 12-18).

Regarding claim 6, Bennett discloses the predetermined criterion is a maximum number which indicates how many objects may remain stored in the memory (see col. 4 lines 3-6).

Regarding claims 7 and 9, Bennett discloses A network element for a digital communications network comprising a controller (FLT) (see fig. 1B) for managing the network element using managed objects (MO1, M02, MO*), a memory (MEM) (see col. 4 line 9) connected to the controller (FLT), and a database (DB) connected to the controller (FLT), wherein the controller (FLT), in response to requests (RQ), manages the network element by accessing the memory (MEM) and using the objects (M01, M02, MO*) stored therein (see fig. 9), wherein in response to a request (RQ = RQ*) for access to one (MO*) of the managed objects (M01, M02, MO*), the controller (FLT) checks whether this requested object (MO*) is stored in the memory (see col. 7 lines 6-9), wherein, if this requested object (MO*) is not stored in the memory (MEM), the controller (FLT) checks whether there is sufficient memory space to write this object (MO*) into the memory (MEM) (see col. 7 lines 9-13), wherein, if there is no sufficient

memory space, the controller (FLT) causes at least one (M01) of the stored objects (MO1, M02) to be swapped out of the memory (MEM) to a database (DB) according to at least one predetermined criterion (see col. 7 lines 13-18), and wherein the controller (FLT) reads the requested object (MO*) from the database (DB) and writes it into the memory (MEM) (see col. 7 lines 18-24).

Regarding claim 8, Bennett discloses the memory is a semiconductor memory (MEM), and wherein the database (DB) is implemented on a nonvolatile mass storage, particularly on a hard disk (see col. 7 lines 20-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Finni (USPN 5,941,978).

Regarding claim 4, Bennett does not teach CMISE filter as claimed. However, Finni teaches the predetermined criterion is a filter function, particularly a CMISE filter function, which indicates which objects are to remain stored in the memory (see col. 1 lines 36-63 and col. 4 lines 14-44). Therefore, it would have been obvious to have used the CMISE filter function in Bennett as taught by Finni because it enables the network management system to select a target group for CMIP management operation applied to a network element of a communication network.

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3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Hayball et al (Hayball) (USPN 6,233,610).

Regarding claim 10, Bennett does not teach SDH network as claimed. However, ~~stay with~~ Finni teaches particularly an SDH network (see col. 25 lines 32-40), wherein the network elements are cross-connects, add-drop multiplexers, and/or line multiplexers (see col. 21 lines 16-33). Therefore, it would have been obvious to have the network elements in Bennett as taught by Hayball because such network elements would provide a communications network having network management system which is adaptable to being distributed across a communications network and enable faster construction of network management base for communications network.

4. Applicant's arguments filed 03/15/02 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "managing a network element using managed objects" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to Applicant's argument that Bennett does not disclose, teach or suggest "managing a network element using managed objects," the law of anticipation requires that a distinction be made between the invention describes or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Bennett discloses checking in response to a request for access to one of the managed objects whether this requested object is stored in the memory (see col. 7 lines 6-9); if this requested object is not stored in the memory, checking whether there is sufficient memory space to write this object into the memory (see col. 7 lines 9-13); if there is no sufficient memory space, swapping at least one of the stored objects out of the memory to a database according to at least one predetermined criterion (see col. 7 lines 13-18); and reading the requested object from the database and writing it into the memory (see col. 7 lines 18-24).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM-4: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

O.D

O.D
May 28, 2002


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100